

### **REMARKS**

The Office Action dated October 13, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claim 4 has been canceled, claim 10 has been added and claims 1-3 and 5-9 are amended. Claim 10 is based on amended claim 1. No new matter has been added. Claims 1-3 and 5-10 are pending and respectfully submitted for consideration.

Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hassett et al. (U.S. Patent No. 5,144,553, "Hassett") in view of Deaton et al. (U.S. Patent No. 6,611,811 B1, "Deaton"). As a preliminary matter, the Applicant notes that the correct patent number for Deaton should be 6,611,811 B1. Claim 4 has been canceled. Claims 2, 3, 5, 7 and 8 depend from claim 1 and claim 9 depends from claim 6.

Hassett was cited for disclosing many of the claimed elements of the invention with the exception of setting the initial numbers of media higher with purchase dates during an earlier time period. Deaton was cited for curing this deficiency. The Applicant traverses the rejection and respectfully submits that claims 1-3 and 5-9 recite subject matter that is neither disclosed nor suggested by the cited references.

Hassett discloses a system for automatic collection of tolls, including a toll facility, an in-vehicle toll processor having memory for storing a toll-money-available quantity purchased by the user, and a toll-facility-identification site that transmits a toll-facility-

identifier signal indicating the identity of the upcoming toll facility and the toll to be collected. As the vehicle approaches the identification site, the in-vehicle processor receives the identifier signal and calculates the toll to be debited. When the vehicle passes through the toll facility, the facility transmits a toll-collect signal instructing the in-vehicle toll processor to debit the calculated toll from memory. The in-vehicle processor debits the calculated amount and transmits an acknowledgement signal to the toll facility.

Deaton discloses a method and system for accumulating marginal discounts and applying an associated incentive upon achieving a threshold. The system can also predict a customer's next due date to purchase a type of product. If a customer begins a pattern of buying a certain type of diapers, for example, but the customer is an infrequent shopper or sub-par spender, this system may induce that customer to shop more often or to spend more by issuing an incentive to the customer to purchase diapers at the time which the customer's history has indicated that the customer buys diapers. By tracking the purchase cycle of various products, the system can anticipate the next purchase date in order to issue incentives prior to that anticipated purchase date, or issue other incentives if the next purchase date passes and no purchase is made.

The Applicant respectfully submits that Hassett fails to disclose or suggest additional features of the invention beyond those acknowledged in the Office Action.

Claim 1, as amended, recites an initial value-setting system for setting the initial available number-of-times of unitary use of prepaid available number-of-times-of-unitary-use storage media comprising a means for receiving purchase-application data

on each medium including its purchase date and time. Amended claim 1 also recites a storage area for storing the opening date and time of advance sale of the media, a storage area for storing the closing date and time of the advance sale, and a storage area for storing the closing date and time of ordinary sale. Amended claim 1 further recites an initial value-setting means for setting the initial numbers of media purchase dates and times between the opening and closing media and times higher than those of media with purchase dates and times between the closing dates and times of the advance and ordinary sales.

Amended claim 6 recites an operating system of prepaid available number-of-times-of-unitary-use storage media for making use of a certain toll or pay service comprising the initial value-setting device according to claim 5, which sets the initial available number of times the unitary use of the media and has a means for transmitting the initial number to the initial value-setting device.

The Office Action took the position that Hassett discloses a number-of-times-of-unitary-use storage media. In contrast, the Applicant respectfully submits that Hassett discloses an in-vehicle component (IVC 16), which contains a transponder, microprocessor, and memory, for storing, manipulating, and reporting on a quantity representative of money available to the vehicle for debiting and toll transactions. See column 4, lines 18 – 24 of Hassett. Further, in contrast to the Office Action assertion, Hassett discloses that when a motorist wishes to prepay tolls and load the IVC, the motorist proceeds to the local toll facility and gives the IVC to the toll collection agent, with cash or credit card authorization equal to the toll amount the motorists wishes to prepay. The cash terminal 17 transmits a signal to the IVC 16 in Hassett indicating a

credit for the specified monetary amount to the selected account for the IVC. The cash terminal also prints a receipt verifying the credit to the account. This receipt can specify all toll transactions involving the IVC since the previous cash transactions. See column 17, lines 1-21 of Hassett.

The Office Action also took the position that Hassett discloses a storage area for storing the opening date and time of advance sale of the media, a storage area for storing the closing date and time of the advance sale, and a storage area for storing the closing date and time of ordinary sale. The Applicant respectfully submits that Hassett merely discloses a Toll Transaction Management (TTM) system 32 for reporting toll transactions for the toll authority. The TTM subsystem 32 maintains a record of all past transactions, -i.e., toll amount purchases – and automated toll debit transactions. The subsystem can include a data memory and storage module 143 having conventional RAM, magnetic, optical or other digital data memory and storage elements. See column 16, lines 33-48 of Hassett.

As such, with respect to amended claim 1, there is no disclosure or suggestion in Hassett of at least the combination of features of a system having at least the features of a having a prepaid available number-of-times-of-unitary use storage media; at least three different storage areas, including a storage area for storing the opening date and time of advance sale of the media, a storage area for storing a closing date and time of the advance sale, and a storage area for storing the closing date and time of ordinary sale; an initial value-setting means for setting the initial numbers of media with purchase dates and times; and a means for receiving purchase/application data on each medium including its purchase date and time. The IVC 16 in Hassett merely stores a toll amount

which is a monetary value, and is not comparable to number-of-times-of-unitary use recited in claim 1. Additionally, Hassett merely discloses the storage module 143 having conventional RAM, magnetic, optical or other digital data memory and storage elements. Further, there is no disclosure that the IVC itself contains purchase date and time. In contrast, Hassett merely discloses that the cash terminal 17 can interrogate individual IVC unit 16 to produce printed diagnostic reports or travel reports. See column 17, lines 22-25 of Hassett. Nor is there is no distinction between advance sales and ordinary sales in Hassett.

With respect to claim 6, there is no disclosure or suggestion in Hassett of at least the combination of features of a prepaid available number-of-times-of-unitary use storage media and an initial value-setting device which sets the initial available number of times the unitary use of the media. The IVC 16 in Hassett merely stores a toll amount which is a monetary value, and is not comparable to number-of-times-of-unitary use recited in claim 6. As discussed above, Hassett merely discloses adding toll amount to the IVC unit 16.

Accordingly, with respect to claims 1 and 6, the Applicant respectfully submits that Hassett does not disclose or suggest the features of the invention as alleged in the Office Action. The Applicant respectfully submits that Deaton fails to cure the deficiencies in Hassett.

The Office Action acknowledged that Hassett fails to explicitly disclose setting the initial numbers of media higher with purchase dates during an earlier time period. Deaton was cited for teaching providing an incentive for customers who made purchases during earlier time periods. See page 3, lines 5-7 of the Office Action. The

Applicant notes that Deaton merely discloses a system that can anticipate the next purchase date in order to issue incentives prior to that anticipated purchase date. See column 70, lines 11-14 in Deaton. Thus, Deaton fails to cure the deficiencies in Hassett, as Deaton fails to disclose or suggest at least the feature of initial value-setting means, as claimed in amended claims 1 and 6. In Deaton, the system anticipates the next purchase date in order to issue incentives prior to that anticipated purchase date. However, the anticipated purchase date in Deaton is not an initial purchase, but is after the initial purchase.

The Office Action took the position that Hassett discloses the structural limitations recited in claims 1 and 4, and that the functional limitations of claims 1 and 4 do not distinguish the claimed invention over Hassett. See paragraph 2 of the Office Action. As noted above, claim 4 has been canceled. The Applicant respectfully submits that claim 1, as amended, recites structural limitations that are not disclosed or suggested by Hassett, as discussed above.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 1-3 and 5-9 under 35 U.S.C. §103.

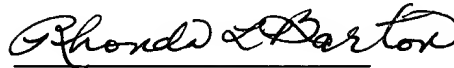
Claims 2, 3 and 5, 7 and 8 depend from claim 1 and claim 9 depends from claim 6. The Applicant respectfully submits that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicant respectfully requests withdrawal of the rejections, allowance of claims 1-3 and 5-10 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper,

may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107390-00006.**

Respectfully submitted,



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Enclosures: Petition for Extension of Time (one-month)  
Information Disclosure Statement; PTO SB/08a (w/3 references)

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